

REMARKS

This document relates to issues raised in the examiner's final office action mailed 07/24/2008. In that office action, claims 64-114 were rejected by the examiner under 35 U.S.C. § 102 and/or 35 U.S.C. § 103. A primary reference used by the examiner in rejecting the claims is Cannon et al. (US Pub No. 20020183105). This documents is supplemental to the remarks/arguments presented in Applicant's Amendment D response filed on November 24, 2008.

On page 6 of the final office action, the examiner asserts:

16. *Cannon as shown above teaches all the present invention but fail to teach the different kind of payout outcome (i.e. taxable payout event, jackpot payout event and WAP payout event) as the lockup event. However, as shown above Cannon teaches that the lockup event is a specified game configuration such as a winning outcome. For a designer to choose to configure the lockup event to be that of a taxable payout event, jackpot payout event or a WAP payout event is strictly dependent on the designer's choice. Thus, the examiner views these limitations as a matter of design choice well within the skill set of an ordinary skilled artisan.*

Applicant respectfully disagrees for a least of the reasons stated herein.

For example, the additional limitations recited in depending claims 134-137 are not merely a matter of design choice, but provide for specific additional benefits, features, and/or advantages over Cannon and/or other conventional gaming machine devices.

For example, as described, for example, on page 1 of the specification of the present application, typically, when playing a game on a casino gaming apparatus, the entire gaming apparatus may be disabled when a jackpot or other large payout determination occurs. As a result, the player would typically have to wait for an attendant to re-enable or reset the gaming apparatus to allow the player to continue playing a game on that gaming apparatus. This often requires the player to remain near the gaming apparatus until the arrival of the attendant, thereby limiting the player's ability to wager on an alternate gaming apparatus. A player typically has to wait by the gaming apparatus until the attendant arrives, fill out papers and receive the payout before the gaming apparatus is reset. Sometimes it can take a relatively long time (e.g., 5-30 minutes) just for the attendant to arrive. Only when the gaming apparatus is reset can the player resume playing games on that gaming apparatus.

In addition to the gaming apparatus being disabled when a jackpot is won, other circumstances may also disable the gaming apparatus. For example, value payouts over a predetermined amount (not necessarily a jackpot), may cause the gaming apparatus to be disabled. This may sometimes be due to casino requirements that an attendant deliver the payout by hand and/or governmental regulations requiring the preparation of tax forms. Cumulative winnings may also disable the gaming apparatus for similar reasons.

To overcome at least some of these issues, the present claimed embodiments provide a casino gaming device that is capable of allowing a player to continue game play on the gaming apparatus during a lockup of a game on the gaming apparatus. Thus, for example, in situations where the player is required to remain near the gaming apparatus until the arrival of the attendant, the claimed gaming device embodiments of the present application allow the player to continue game play on the gaming apparatus even during times when the gaming device has been locked up and/or disabled.

Moreover, as explicitly taught in paragraph [0129] of Cannon, the gaming machine of Cannon allows a to play a plurality of games (preferably different games) until one game achieves a specific outcome. The game with the specific outcome may then be then "locked up" (i.e., is frozen and unavailable for play) and the player is given a predetermined number of plays (for example, ten) or predetermined time period (for example, two minutes) in which to achieve a specific outcome in at least one of the remaining games.

However, it is respectfully submitted that a hand payout event (necessitating manual or hand payout of a first payout amount to the first player in connection with the first active gaming session) as recited in claim 134, for example, is not representative of an intended "game outcome" as taught in paragraph [0129] of Cannon. Further, it is respectfully submitted that one having ordinary skill in the art would not consider a hand payout event (e.g., necessitating manual or hand payout of a first payout amount to the first player in connection with the first active gaming session) to be representative of an intended "game outcome" as taught in paragraph [0129] of Cannon.

Additionally, it is respectfully submitted that a taxable payout event (necessitating manual documentation of a first payout amount to the first player in connection with the first active gaming session) as recited in claim 135, for example, is not representative of an intended "game outcome" as taught in paragraph [0129] of Cannon; and, it is respectfully submitted that one having ordinary skill in the art would not consider a taxable payout event (necessitating manual documentation of a first payout amount to the first player in connection with the first

active gaming session) to be representative of an intended "game outcome" as taught in paragraph [0129] of Cannon.

Similarly, it is respectfully submitted that a wide area progressive (WAP) value payout event, as recited in claim 136, for example, is not representative of an intended "game outcome" as taught in paragraph [0129] of Cannon; and it is respectfully submitted that one having ordinary skill in the art would not consider a wide area progressive (WAP) value payout event to be representative of an intended "game outcome" as taught in paragraph [0129] of Cannon.

Additionally, it is noted that design choice may be related to rearranging parts (MPEP 2144.04) or may be related to substituting one well known element for another where both elements perform similar functions. However, the Examiner has not provided any evidentiary support from the cited prior art to support the proposed modifications and/or assertions made by the Examiner. For example, the Examiner has not presented any evidentiary support relating to any of the exemplary rationales of MPEP 2143, nor has the Examiner presented any analysis or discussion of the Graham factors with respect to the obviousness rejection of previously pending claims 79-81, 98-100, and 110-112.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 127 S. Ct 1727 citing *In re Kahn*, 441 F. 3d 977, 998. Because no articulated reasoning has been provided showing why one of ordinary skill would make such a design choice, no prima facie case of obviousness is stated.

Accordingly, Applicant respectfully submits that the Examiner's applying of an obviousness-type "design choice" rejection in this manner is not consistent with what is taught in the MPEP and/or case law with regard to constructing an Obviousness rejection. Thus, also in this regard, Applicant believes that a prima facie case of obviousness has not been properly established by the Examiner, and that the rejected claims should not be said to be rendered obvious by Cannon.

Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,

WEAVER AUSTIN VILLENEUVE & SAMPSON, LLP

/DEW/

Dean E. Wolf

Reg. No. 37,260

P.O. Box 70250
Oakland, CA 94612-0250
(510) 663-1100